

U.S. Patent Application Serial No. 09/924,476
Response to Office Action dated May 28, 2004
Response to Notice of Non-Compliant Amendment dated September 20, 2004

REMARKS

Claims 1-6 are pending in this application, of which claim 1 has been amended. No new claims have been added.

The Examiner has objected to the amendment filed February 24, 2004 under 35 USC §132 for introducing new matter into the disclosure. The alleged new matter is the change of "Examples 1-1 to 1-6" to "Examples 1-4 to 1-6" in the paragraph on page 20, line 9 of the specification. This paragraph indicates, among other things, that phosphorous is contained in the chemical conversion film formed by using the treatment solution of various examples shown in Table 1 on page 21. Only examples 1-4, 1-5 and 1-6 in Table 1 show the presence of phosphoric acid. Examples 1-1, 1-2 and 1-3 do not show any presence of phosphoric acid. Thus, the objection should be withdrawn to the amendment because the correction is clearly typographical and does not introduce new matter.

The Examiner has maintained from the previous Office Action the 35 USC §102(b) rejection of claims 1-6 as anticipated by Nichiuchi et al. (JP '216) and the 35 USC §103(a) rejection of claims 1-6 as being unpatentable over JP '216.

Applicants respectfully traverse this rejection.

Applicants have previously argued that Nichiuchi et al. teaches that an aluminum film is required between the surface of the magnet and the chemical conversion coating, while no aluminum film is necessary in the present invention. The Examiner has stated:

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Although applicant argues that the aluminum is “necessary” for the formation of the chemical conversion coating, the presence or absence of aluminum is not relevant because aluminum in some form is not precluded from the claim language, as presently drafted. The teachings of JP ‘216 (paragraph [0030] state that there is a conversion coating (i.e. a coating resulting from a reaction between the coating substance and the substrate magnet) on the surface of the magnet. It is further noted that the applicant is claiming a conversion coating (i.e. a product), and is not claiming the process. Therefore, the process to achieve the product is not a limitation in the claim. The test wherein there is no aluminum does not distinguish the claimed invention.

Accordingly, claim 1 has been amended to recite that the chemical conversion film is provided directly on the surface of the permanent magnet and that there is no aluminum film provided between the surface of the magnet and the chemical conversion film.

In an interview conducted with the Examiner on July 29, 2004, Applicants’ attorney argued the patentability of the newly-proposed limitation “there is no aluminum film provided between the surface of the magnet and the chemical conversion film.”

The Examiner did not dispute the novelty of such a limitation over the prior art, but did take the position that support for such a negative limitation is not supported in the specification under 35 USC §112, first paragraph. The Examiner cited MPEP §2173.05(i).

Applicants respectfully disagree with the Examiner.

Ex parte Parke, 30 USPQ2d 1234 (Bd. Pat. App. & later. 1993) stands for the proposition that lack of a literal basis in the specification for a negative limitation may not be sufficient to establish a *prima facie* case for lack of descriptive support. The originally-filed disclosure need

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only convey, to one of ordinary skill in the art, that the applicant had possession or the concept of what is claimed in order to satisfy the written description requirement. Lack of literal basis in the disclosure for the limitation that a claimed decomposition step “be conducted in the absence of a catalyst” does not establish a *prima facie* case for lack of descriptive support, and it cannot be held that the originally-filed disclosure would not have conveyed the concept of effecting decomposition at elevated temperatures in the absence of a catalyst.

In the instant case, the specification discloses that the chemical conversion film, which does not contain aluminum as a possible choice for the constituent component (a) in claim 1, is provided directly on the surface of the magnet. Thus, it would be clear to one of ordinary skill in the art that no aluminum film could be provided between the surface of the magnet and the chemical conversion film.

Thus, the 35 USC §102(b) rejection and the 35 USC §103(a) rejection should both be withdrawn.

In view of the aforementioned amendments and accompanying remarks, claims 1-6, as amended, are in condition for allowance, which action, at an early date, is requested.

If, for any reason, it is felt that this application is not now in condition for allowance, the Examiner is requested to contact Applicants’ undersigned attorney at the telephone number indicated below to arrange for an interview to expedite the disposition of this case.

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In the event that this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. Please charge any fees for such an extension of time and any other fees which may be due with respect to this paper, to Deposit Account No. 01-2340.

Respectfully submitted,

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